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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,293	03/12/2004	Sachio Muraki	250208US2DIV	6438
22850	7590	06/23/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FISHMAN, MARINA	
			ART UNIT	PAPER NUMBER
			2832	
DATE MAILED: 06/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/798,293	<b>Applicant(s)</b> MURAKI ET AL.
	<b>Examiner</b> Marina Fishman	<b>Art Unit</b> 2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 8-12 is/are rejected.
- 7) ☒ Claim(s) 13-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/986,007.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/12/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***General status***

1. This is a First Action on the Merits. Claims 8 - 29 (claims 1 – 7 are canceled) are pending in the case and are being examined.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/986,007, filed on 11/07/2001.

### ***Claim Objections***

3. Claims 8, 13, 14, 23 and 28 are objected to because of the following informalities: in line 8 word "filling" should be corrected as –filled--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi et al. [US 6,545,241] in view De Calvino y Teijeiro [US 4,486,635].

Franchi et al. disclose a gas-insulated switching device comprising:

- a plurality of switching devices each including a contact and an insulated container in which the contact is contained

[51,52,53; Figures 1,2], the contact comprising electrodes adapted to be contacted with each other and separated therefrom, the insulated container filled with an insulating gas;

- a container [4] to which the plurality of switching devices are connected, respectively; and
- the plurality of switching devices are only two switching devices of different types [7,24];
- terminal [71 – 73].

Regarding Claim 8, Franchi et al. disclose the instant claimed invention except for an insulating structure. De Calvino y Teijeiro disclose a gas-insulated switching device having an insulating structure [13]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the insulating structure in Franchi et al., as suggested by De Calvino y Teijeiro, in order to provide support for the container.

Regarding Claim 8, Franchi et al. disclose the instant claimed invention, however do not specify material of the container. De Calvino y Teijeiro disclose a switching device having metal container [18]. Franchi et al. [Column 9, lines 25 – 33] stated, " ... the materials, so long as they are compatible with the specific use, as well as the individual components, may be any according to the requirements and the state of the art", therefore it would have been obvious to one having ordinary skill in the art at the

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time the invention was made to have container formed of conductive material in Franchi et al., as suggested by De Calvino y Teijeiro.

***Allowable Subject Matter***

6. Claims 13 – 29 are allowed, subject to objection in §2 above.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamauchi et al. [US 5,898,565], Piazza [US 6,444,937], Perret et al. [US 5,668,360], Piazza [US 6,573,469] all disclose switching devises. Applicant also should consider these references in response to this office action. Should issue arise concerning the rejection presented above, these references may be relied upon in a subsequent action to support the lack of novelty or obviousness of claimed subject matter to one of ordinary skill in the art.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is 571-272-1991. The examiner can normally be reached on 7-5 M-T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Fishman  
June 16, 2004

  
LINCOLN DONOVAN  
PRIMARY EXAMINER  
GROUP 2100